

REMARKS

In the Official Action, restriction is required as between allegedly patentably distinct species of the claimed invention. The species are divided between Group I and Group II, with Group I allegedly drawn to Fig. 2 and Group II allegedly drawn to Fig. 3. Claim 3 is allegedly readable on the species of Group I and claims 4-7 are allegedly readable on the species of Group II.

This restriction requirement is respectfully traversed.

Election of Species Under Traverse

In response, as a formality merely to comply with §818.03(b), Applicants hereby preliminarily elect the species defined by Group II allegedly drawn to Fig. 3. Claims 4-7 are readable on the elected species. Claims 1-2 and 8-10 are deemed generic, and therefore encompass the elected invention.

Arguments in Support of Traversal of Restriction

As a first point, the Office Action has not made a *prima facie* showing that the supposed "species" are patentably distinct. It is not Applicants' burden to show they are not distinct. Likewise it is not incumbent upon Applicants to admit that subgroups of claims are obvious variants of other groups of claims.

The Office states that "the species relate to different structural features to effect the impedance control". The Office's apparent reason for restriction is entirely conclusory and does not establish *prima facie* that restriction is required. The species of Groups I and II are drawn to different dependent claims. In general, different dependent claims necessarily recite at least one different structural feature; otherwise, different dependent claims reciting the exact same features would be deemed duplicative. According to the Office's reasoning, every claim by its nature (as reciting at least one different feature)

in every case, is subject to restriction. Since every claim in every case is not necessarily subject to restriction, the Office must clearly show something more. The Office must show *prima facie* that the restricted claims are “independent” and “distinct”. The MPEP defines “independent” and “distinct”. The Office is required to show with reasonable explanation that the restricted claims are “independent” and “distinct”. The Office has not yet made such a showing.

Furthermore, Applicants respectfully submit that the claims are not drawn to separate species. This fact should be clear merely from the restricted claims depending from claim 2. Each of the restricted claims is drawn to “An electrode assembly” with “impedance control means”.

MPEP §806.4 provides examples of when restriction is proper:

806.04 Independent Inventions

If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. For example:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

(B) Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process.

(C) Where species under a genus are independent, for example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.

Clearly none of the above examples are applicable in the case wherein each restricted claim is drawn to “An electrode assembly” with “impedance control means”.

In addition, the MPEP in §803 makes clear that a restriction between patentably distinct inventions is only proper if the inventions are independent or distinct as claimed and there is a serious

burden on the examiner if a restriction is not required. A serious burden on the examiner is prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search (see, further MPEP §808.02). However, where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." There is no showing of a separate classification, separate field of search, or any showing of additional burden on the Examiner for searching and examining the claims together in one patent application. Clearly none of the above examples are applicable in the case wherein each claim is drawn to "An electrode assembly" with "impedance control means".

It is noted that claim 3 is the sole member of non-elected Group I. It is difficult for Applicants to believe that the inclusion of claim 3 in the examination of the application would present a serious burden on the examiner.

Accordingly, it is respectfully submitted that restriction is improper. It is therefore respectfully requested that the restriction requirement be withdrawn and that the claims be examined on the merits.

Respectfully submitted,

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